

REMARKS

In the Final Office Action, the Examiner objected to claim 8 as depending on canceled claim 6; rejected claims 1-4 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement; rejected claims 1-2 and 20-23 under 35 U.S.C. § 102(e) as being anticipated by NAGAMI et al. (U.S. Patent No. 5,835,710); rejected claims 3 and 24 under 35 U.S.C. § 103(a) as being unpatentable over NAGAMI et al. (U.S. Patent No. 5,835,710) in view of BORELLA et al. (U.S. Patent No. 6,731,642); and rejected claims 5, 7-8 and 11-18 under 35 U.S.C. § 103(a) as being unpatentable over BORELLA et al. (U.S. Patent No. 6,731,642) in view of HAN (U.S. Patent No. 6,351,465).

Claims 1-5, 7, 8, 11-18 and 20-24 were pending in the present application prior to the above amendments. Claim 22 has been canceled without prejudice or disclaimer and claims 8 and 23 have been amended to improve form. Accordingly, claims 1-5, 7, 8, 11-18 and 20, 21, 23, and 24 will be pending upon entry of this Amendment. Reconsideration and allowance of all claims in view of the following remarks are respectfully requested.

Claim Objections

Initially, claim 8 was objected to for being improperly dependent upon a canceled claim. Accordingly, claim 6 has been amended to correct the erroneous dependency. Reconsideration and withdrawal of the pending objection is respectfully requested.

Rejections Under 35 U.S.C. § 112

Claims 1-4 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. More specifically, claim 1 was rejected for including the phrase “securing the ATM virtual circuit by use of proxy addressing.” The Examiner indicated that this phrase is not described in the specification in such a way as to reasonably convey to one skilled in the art possession of the claimed invention. More particularly, the Examiner indicated that the specification describes the proxy used in the IP network not in the ATM network. Applicants respectfully traverse.

The proxy addressing described in the present application provides security in establishing and using the ATM connections used to exchange media in an IP telephony session. As described in the specification at pg. 5, lines 7-16, proxy addressing is used to modify the media addresses included within the signaling messages exchanged between the calling party and the called party. In particular, pg. 5 at lines 7-8 discloses that “the data path for the session is secured against unauthorized traffic by the use of proxy addressing.” The assigned proxy address points to an ephemeral port on a respective access control manager. The addresses of the ports are then used to create and transmit the ATM connection. Accordingly, the proxy addressing may be properly interpreted as securing the ATM virtual circuit, as recited in claim 1. Claims 2-4 depend from claim 1 are believed to be properly supported for at least the reasons set forth above, with respect to claim 1. Reconsideration and withdrawal of the pending rejection under 35 U.S.C. § 112, first paragraph are respectfully requested.

Although not specifically rejected, the Examiner also implies that claim 22 may be rejected under 35 U.S.C. § 112, first paragraph, for also allegedly failing to comply with the written description requirement. More specifically, the Examiner indicated that

the phrases “ATM intelligent controller providing session setup signaling to said first and second devices” and “IP intelligent controller providing call setup signaling to said ATM intelligent controller” are not adequately described in the specification. In particular, the Examiner indicates only that the specification describes a MSCP as providing an intelligent control layer for the establishment of an IP telephony session. Claim 22 has been canceled without prejudice or disclaimer.

Rejections Under 35 U.S.C. § 102

Claims 1-2, 4, and 20-23 were rejected under 35 U.S.C. § 102(e) as being anticipated by NAGAMI et al. Applicants respectfully traverse.

A proper rejection under 35 U.S.C. § 102 requires that a reference teach *each and every aspect* of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. See M.P.E.P. § 2131. NAGAMI et al. does not disclose, either explicitly or inherently, each of the features recited in Applicant’s claims 1-2, 4, and 20-23.

For example, independent claim 1 recites a method for providing quality of service in an Internet Protocol (IP) telephony session between a calling party and a called party. The method includes transporting IP telephony media for the session between the calling party and a first device having IP telephony capability and ATM capability. IP telephony media for the session is transported between the called party and a second device having IP telephony capability and ATM capability. An ATM virtual circuit is established for the session between the first device and the second device. The ATM virtual circuit is secured by use of proxy addressing. NAGAMI et al. fails to disclose the combination of features recited in Applicants’ claim 1.

In particular, NAGAMI et al. does not disclose or even remotely suggest securing the ATM virtual circuit by use of proxy addressing, as recited in claim 1. In fact, the Office Action is completely silent with respect to this feature. For at least this reason, Applicants respectfully submit that the Examiner has failed to make a *prima facie* case of anticipation, with respect to claim 1.

Claims 2 and 4 depend from claim 1. Accordingly these claims are not anticipated by NAGAMI et al. for at the reasons set forth above, with respect to claim 1. Reconsideration and withdrawal of the rejection of claims 2 and 4 are respectfully requested.

Regarding claims 20-23, Applicants note that the Examiner continues to fail to provide a separate analysis for independent claim 20. More specifically, no indication is provided where any of the claim elements recited in claim 20 may be found in NAGAMI et al. or BORELLA et al. Claim 20, as presented, recites significantly different features than those recited in independent claim 1, which was addressed by the Examiner. In particular, claim 20 recites a system for providing a quality of service IP telephony session between a calling party and a called party. The system includes a first device connected between an IP network and an ATM network, where the first device provides bidirectional translation between IP media traffic and ATM traffic. A second device is connected between the IP network and the ATM network, the second device providing bidirectional translation between ATM traffic and IP media traffic. An intelligent control layer is provided for establishing a virtual circuit through the ATM network for an IP telephony session between the calling party and the called party, wherein the first device and the second device are assigned on a per session basis.

Clearly, the rejection of claim 1 can not apply to the language of claim 20. More specifically, the Examiner fails to point out where NAGAMI et al. discloses an intelligent control layer for establishing a virtual circuit through the ATM network for an IP telephony session between the calling party and the called party, wherein the first device and the second device are assigned on a per session basis. No discussion of this feature is made whatsoever. Therefore, a prima facie case of anticipation under 35 U.S.C. §102 has not been made.

For at least the foregoing reasons, Applicants submit that claim 20 is not anticipated by NAGAMI et al.

Claims 21 and 23 depend from claim 20. As noted above, claim 22 has been canceled without prejudice or disclaimer. However, claims 21 and 23 are considered patentable over NAGAMI et al. for at least the reasons given above with respect to claim 20

Rejections under 35 U.S.C. § 103

Claims 3 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over NAGAMI et al. In view of BORELLA et al. Applicants respectfully traverse.

A proper rejection under 35 U.S.C. § 103 requires that three basic criteria be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest each and every claim limitation. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be

found in the prior art, not the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The cited combination of NAGAMI et al. and BORELLA et al. fail to disclose or reasonably suggest the combination of features recited in Applicants' claims 3 and 24.

Claims 3 and 24 depend from claims 1 and 20, respectively. The disclosure of BORELLA et al. does not remedy the deficiencies of NAGAMI et al., as set forth above with respect to claim 1 and 20. More specifically, although BORELLA discloses the concept of proxy addressing in an IP telephony system, BORELLA et al. does not disclose or even remotely suggest securing an ATM virtual circuit by use of proxy addressing. For at least these reasons, claims 3 and 24 are considered patentable over the cited combination of NAGAMI et al. and BORELLA et al., either alone or in any reasonable combination.

Claims 5, 7-8, and 11-18 were rejected under 35 U.S.C. § 103(a) as unpatentable over BORELLA et al. in view of HAN. Applicants respectfully traverse.

Independent claim 5, recites a method of providing quality of service in an IP telephony session between a calling party and a called party. The method includes assigning a temporary IP proxy address to the called party at a first access control manager. A temporary IP proxy address is assigned to the calling party at a second access control manager. A switched virtual circuit for the session is established between the first access control manager and the second access control manager. IP media traffic is routed from said calling party to said called party IP proxy address at said first access control manager. IP media traffic is routed from said called party to said calling party IP proxy address at said second access control manager. IP media traffic received at said called party IP proxy address is translated to ATM traffic for transport through said

virtual circuit from said first access control manager to said second access control manager. IP media traffic received at said calling party IP proxy address is translated to ATM traffic for transport through said virtual circuit from said second access control manager to said first access control manager. The cited combination of BORELLA et al. and HAN fails to disclose or reasonably suggest the combination of features recited in Applicants' claim 5.

For example, neither BORELLA et al. nor HAN discloses or suggests translating the IP media traffic received at said called party IP proxy address to ATM traffic for transport through said virtual circuit from said first access control manager to said second access control manager and translating the IP media traffic received at said calling party IP proxy address to ATM traffic for transport through said virtual circuit from said second access control manager to said first access control manager. The Examiner admits that BORELLA et al. does not disclose these features (Office Action, pg. 5). The Examiner cites HAN to remedy this deficiency. However, Applicants respectfully submit that HAN likewise fails to disclose or reasonably suggest the recited features. In making the rejection, the Examiner relied on col. 8, lines 15-18 of HAN for allegedly disclosing the claimed features (Office Action, pg. 5). Applicants respectfully submit that this section of HAN does not disclose or suggest translating received IP media traffic into ATM traffic for transport through the virtual circuit, as recited in Applicants' claim 5.

At col. 8, lines 15-18, HAN discloses:

converting the Internet protocol addresses in ATM addresses;
establishing a cut-through switched virtual path using ATM standard signaling;

This section of HAN (a portion of claim 1), as described in the specification at col. 5, lines 25-31, discloses that the IP addresses for the end users (24 and 26) are translated into the ATM address of their directly attached routers, thus enabling creation

of a cut-through path that avoids ATM routers through use of virtual paths. Clearly, this address translation is not analogous to translating received IP media *traffic* into ATM *traffic* for transport through the virtual circuit, as recited in Applicants' claim 5. For at least this reason, claim 5 is patentable over the cited combination of BORELLA et al. and HAN. Reconsideration and withdrawal of the pending rejection is respectfully requested.

Claims 7, 8, and 11 are dependent on claim 5. Accordingly, these claims are patentable over BORELLA et al. and HAN for at the reasons set forth above with respect to claim 5. Reconsideration and withdrawal of the rejection of claim 7, 8, and 11 are respectfully requested.

Independent claim 12 recites features similar to claim 5. Accordingly, claim 12 is patentable over the cited combination of BORELLA et al. and HAN for at least reasons similar to those recited above with respect to claim 5. Claims 13-18 depend from claim 12. Accordingly these claims are patentable over BORELLA et al. and HAN for at the reasons set forth above, with respect to claim 12. Reconsideration and withdrawal of the rejection of claim 13-18 are respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the Examiner's reconsideration of this application, and the timely allowance of the pending claims. Furthermore, entry of the above Amendments are respectfully requested. The above Amendments involved only modification of a claim dependency and correction of a minor informality. No further search is believed to be necessitated by the above Amendments.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 13-2491 and please credit any excess fees to such deposit account.

Respectfully submitted,

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